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FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			MITCHELL, JASON D	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/854,111
Filing Date: May 11, 2001
Appellant(s): WONG ET AL.

Michael J. Marcin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/2/06 appealing from the Office action
mailed 11/1/05.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 12/28/05 has not been entered.

While Appellant has acknowledged that the after final amendment was not entered, it was also stated "All amendments submitted by the appellants after the June 27, 2005 non-final Office Action have been entered" (see section 4 of pg. 2). This statement is submitted to clarify any contradiction.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,704,736 to Rys et al. (Rys) in view of US 6,662,186 to Esquibel et al. (Esquibel)

NEW GROUND(S) OF REJECTION

Claims 1-6 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,662,186 to Esquibel.

Upon further consideration, it has been determined that the Esquibel reference (US, 6,662,182) which has previously been used as a secondary reference modifying the Rys reference (US 6,704,736) does, in itself, provide anticipation of the limitations recited in claims 1-6 and 12-16. Accordingly a rejection of these claims is presented under 35 USC 102(e) over the Esquibel reference

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6704736	Rys et al.	3-2004
6662186	Esquibel et al.	12-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,662,186 to Esquibel.

Regarding Claims 1 and 12: Esquibel discloses a receiving module determining a format of each of a plurality of original files (col. 4, lines 43-47 'the format interpreter 118); and a converter module applying a converter function corresponding to the file format of each of the original files to create new files in a converted file format (col. 4, lines 53-56 'conversion of the file 136 from one file format to another'), wherein the converter module includes an extensible set of converter functions and the converter

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function is selected from the extensible set (col. 4, lines 48-56 "Accordingly, any file conversion intermediary can be stored and available for use in format interpreter 118 ... These and other, formats can be installed in the format interpreter 118 for use by the data propagation logic 200 to enable the conversion of the file 136').

Note, the fact that 'other, formats can be installed in the format interpreter' (col. 4, lines 53-56) indicates, by definition, that the set of functions (col. 4, lines 53-56 'These, and other, formats) is extensible. Further their use in the format interpreter (col. 4, lines 48-49) places them within the scope of the claimed 'converter functions'.

Regarding Claims 2, and 13: the rejection of claims 1 and 12 are incorporated respectively; further Esquibel discloses an application program to access information in the new files, wherein the application program is compatible with the new files and incompatible with the original files. (col. 4, lines 41-43 'Process 106 communicates with format interpreter 118 via connection 122 to analyze and interpret the format associated with file 136')

Regarding Claim 4: The rejection of claim 1 is incorporated; further Esquibel discloses the converter function includes a text parser (col. 4, lines 59-62 'The format interpreter 118 will analyze and parse the file extension associated with the file').

Regarding Claim 6: The rejection of claim 1 is incorporated; further Esquibel discloses the receiving module determines the format of the original files based on file extensions (col. 4, lines 59-62 'The format interpreter 118 will analyze and parse the file extension associated with the file').

Regarding Claim 15: The rejection of claim 12 is incorporated; further Esquibel discloses the plurality of formats of the original files include an extensible markup language (col. 4, lines 49-56 'many file formats, such as XML ... can be installed in the format interpreter').

Regarding Claim 16: The rejection of claim 12 is incorporated; further Esquibel discloses the new files are saved in one of random access memory and permanent memory (col. 5, lines 4-6 'generating the final file that is to be accessed').

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,704,736 to Rys et al. (Rys) in view of US 6,662,186 to Esquibel et al. (Esquibel).

Regarding Claims 1 and 12: Rys discloses a converter module applying a converter function corresponding to the file format of an original file to create new files in a converted file format (col. 6, lines 16-24 'Parser 307 converts XML data file 205 into a format ... such as the document object model'; col. 5, lines 53-55 'parser 307 processes XML data file 205 and stores the processed XML data in active store 309').

Rys does not explicitly disclose a receiving module determining a format of each of a plurality of original files but does disclose several file formats that could be used with his invention (col. 5, lines 4-17 'SGML ... graphs') but does not disclose an extensible set of converter functions.

Esquibel teaches a receiving module determining a format of each of a plurality of original files (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file') and an extensible set of converter functions (col. 4, lines 53-56 'These, and

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other, formats can be installed') from which the converter function is selected (col. 4, lines 43-47 'the appropriate file conversion intermediary') in an analogous art for the purpose of providing access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

Note, the fact that 'other, formats can be installed in the format interpreter' (col. 4, lines 53-56) indicates, by definition, that the set of functions (col. 4, lines 53-56 'These, and other, formats) is extensible. Further their use in the format interpreter (col. 4, lines 48-49) places them within the scope of the claimed 'converter functions'.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an extensible set of converter functions (Esquibel col. 4, lines 43-56) in Rys' converter function (col. 6, lines 16-24 'Parser 307') to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claims 2, and 13: The rejections of claims 1 and 12 are incorporated, respectively; further Rys discloses an application program to access information in the new files (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311'), and the application program is compatible with the new files and incompatible with the original files (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311').

Regarding Claim 3, 10 and 14: The rejections of claims 1, 7 and 12 are incorporated, respectively; further Rys discloses the converted file format is a document object model tree (col. 6, lines 16-24 'XML data file 205 is stored in ... (DOM) format').

Regarding Claim 4: The rejection of claim 1 is incorporated; further Rys discloses the converter function includes a text parser (col. 5, line 50 'Parser 307 processes XML data file 205').

Regarding Claim 5: The rejection of claim 1 is incorporated; further Rys discloses the original files include a configuration file (col. 5, lines 53-55 'stores the processed XML data in active store 309'). Rys' original files ('XML data file') initialize and 'configure' the data upon which the Application ('Query processor') works, and therefore can be considered a configuration file.

Regarding Claim 6: The rejection of claim 1 is incorporated; further Rys does not explicitly disclose determining file format based on file extensions.

Esquibel teaches the receiving module determines the format of the original files based on file extensions (col. 4, lines 32-40 'format as determined by the file extension associated with the file').

Regarding Claim 7: Rys discloses an application module to perform functions, the application module uses information contained in a configuration file to perform the functions (col. 6, lines 47-52 'Query processor 311 ... processes the image of XML data file 205 ... and returns rowset 207'); and a conversion module applying a converter function to the configuration file to convert the configuration file from a first format incompatible with the application module to a second format compatible with the

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application module (col. 6, lines 16-24 'Parser 307 converts XML data file 205 into a format ... such as the document object model'),

Rys inherently discloses that the application program is compatible with the new files and incompatible with the original files. If Rys' application ('query processor') were compatible with the original files ('XML data file') it would not be necessary to convert them (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311').

Rys does not explicitly disclose the conversion module including an extensible set of converter functions from which the converter function is selected.

Esquibel teaches an extensible set of converter functions (col. 4, lines 53-56 'These, and other, formats can be installed') from which the converter function is selected (col. 4, lines 43-47 'the appropriate file conversion intermediary') in an analogous art for the purpose of providing access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an extensible set of converter functions (Esquibel col. 4, lines 43-56) in Rys' conversion module (col. 6, lines 16-24 'Parser 307') to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claim 8: The rejection of claim 7 is incorporated; further, Rys does not explicitly disclose the conversion module includes a plurality of converter functions

corresponding to a plurality of file formats, but does disclose several file formats which could be used with his invention (col. 5, lines 4-17 'SGML ... graphs').

Esquibel teaches a conversion module that includes a plurality of converter functions corresponding to a plurality of file formats (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file') in an analogous art for the purpose of providing access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide Rys' invention with the ability to recognize and parse various file formats as taught in Esquibel because one of ordinary skill in the art would have been motivated to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claim 9: The rejection of claim 8 is incorporated; further, Rys does not explicitly disclose the conversion module includes a receiving element to determine the first format.

Esquibel teaches a conversion module that includes a receiving element to determine the first format (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file')

Regarding Claim 11, 15: The rejections of claims 7 and 12 are incorporated, respectively; further Rys discloses the first format is an extensible markup language (col. 5, line 50 'XML data file 205').

Regarding Claim 16: the rejection of claim 12 is incorporated; further Rys discloses the new files are saved in one of random access memory and permanent memory (col. 6, lines 35-49 'Active store 309 ... such as ... disk drive ... DRAM').

(10) Response to Argument

In the last full paragraph on pg. 6 Appellant states:

The process of converting an XML data file into a format such as a DOM format is not equivalent to "applying a converter function corresponding to the file format of each of the original files *to create new file* in a converted file format" as recited in claim 1 of the present application. The conversion of a file from one format to another format will only reformat the given file. There is no creation of a new file. The old format within a particular file is replaced with the new format within the same file. Thus, as the process of the Rys patent "transforms hierarchical information into a rowset" or "transforms a rowset into hierarchical information," the previous format of the original file will no longer be available.
(emphasis in original)

Examiner respectfully disagrees. Assuming, for the sake of argument, that the Rys reference discloses a system where "the previous format of the original file will not longer be available", Examiner would argue that this 'overwriting' of the original file constitutes the 'creation of a new file'. Since the contents of the file would be "new" once the old file content is overwritten.

Further, Examiner respectfully notes that appellant has provided no explicit evidence that the cited XML data file is destroyed in the conversion process instead appearing to rely on Rys' use of the word 'converts' to support the argument. It is further noted that the limitation in question is a 'converter function'. Thus it should be clear that the functionality that converts a file, meets the limitation of a 'converter function'

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Still further, as shown in Rys' Fig. 3, the cited 'XML data file 205' is distinct from the 'active store 309' and thus it can be seen that the process does in fact create a new file, specifically a document object model (DOM) file representing the data from the XML data file 205 (col. 5, lines 53-55 'parser 307 processes XML data file 205 and stores the processed XML data in active store 309'). Note that this citation discloses storing the processed, or converted 'XML data', not the 'XML data file 205' itself, in active store 309. Thus the DOM file representing the "converted" XML data in Rys is a new file in a converted format, as claimed.

Starting in the paragraph bridging pp. 6 and 7 and continuing through pg. 7, Appellant presents arguments hinging on the incorrect assumption that Rys destroys the original file. Accordingly these arguments are addressed with the rationale presented above.

In the first paragraph on pg. 9, Appellant states:

The Examiner appears to equate "appropriate file conversion intermediary" of Esquibel disclosure to the "converter module" of the present application. However, the file conversion intermediary does not perform an equivalent function as the claimed converter module. Specifically, the file conversion intermediary converts a file from the prior format to another format. The file conversion intermediary does not "create new files in a converted format" as recited by claim 1 of the present application. Similar to the discussion described above in detail regarding the Rys patent, the conversion of a file format is distinct from the creation of a new file in a converted format.

Respectfully, Examiner's statements above regarding the Rys reference apply.

Further, in light of those arguments and because the rejection relied on Rys' anticipation of the "converter module" (col. 6, lines 16-24), Appellant is attempting to apply a piecemeal analysis to the rejection. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

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references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further Examiner respectfully notes that Esquibel explicitly discloses the creation of a new file (col. 7, lines 47-54 'a new file will be formed').

In the paragraph bridging pp. 9 and 10, Appellant goes on to state:

[T]he Esquibel patent does not disclose nor suggest, "the converter module includes *an extensible set of converter functions* and the converter function is selected from the extensible set" as recited in claim 1. ... While the Esquibel patent discloses that many formats may be installed in the format interpreter, the Esquibel patent fails to teach or suggest a plurality of conversion intermediaries [included] within the format interpreter, let alone an extensible set of conversion intermediaries. There is no reference within the Esquibel specification to indicate that multiple file conversion intermediaries are stored or may be stored in the format interpreter in order to create an extensible set of converter functions.

(emphasis in original)

Examiner respectfully disagrees. Esquibel clearly discloses that multiple file conversion intermediaries (col. 4, lines 48-49 'any file conversion intermediary'; col. 4, lines 53-56 'These, and other, formats') are stored in the format interpreter (col. 4, lines 48-49 'can be stored ... in the format interpreter'; col. 4, lines 53-56 'can be installed in the format interpreter'). Further, the fact that 'other, formats can be installed in the format interpreter' (col. 4, lines 53-56) indicates, by definition, that the set of converter functions (col. 4, lines 53-56 'These, and other, formats) is extensible.

The rejection then goes on to state that "it would have been obvious to a person of ordinary skill in the art at the time of the invention to include an extensible set of converter functions (Esquibel col. 4, lines 43-56) in Rys' converter function (col. 6, lines 16-24 'Parser 307') for the purpose of making Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A

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file format ... that was popular just a few years ago may be completely out or vogue today')."

Thus it can clearly be seen that, in combination, Rys and Esquibel teach a receiving module determining a format of each of a plurality of original files (Esquibel col. 4, lines 32-40 'in accordance with the recognized format ... will open the file'); and a converter module applying a converter function corresponding to the file format of each of the original files to create new files in a converted file format (Rys col. 5, lines 53-55 'parser 307 processes XML data file 205 and stores the processed XML data in active store 309'), wherein the converter module includes an extensible set of converter functions (Esquibel col. 4, lines 53-56 'These, and other, formats can be installed') and the converter function is selected from the extensible set (Esquibel col. 4, lines 43-47 'the appropriate file conversion intermediary').

Further, Appellant has not provided any reason why it would not be obvious to combine the teachings of Rys and Esquibel as set forth in the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Jason Mitchell

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Kakali Chaki




**KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**

Tuan Dam



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